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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/776,389	02/10/2004	Daniel Scott Venolia	4860P0539D4	3938

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EXAMINER

BRIER, JEFFERY A

ART UNIT	PAPER NUMBER
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2672

DATE MAILED: 07/28/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/776,389

Applicant(s)

VENOLIA, DANIEL SCOTT

Examiner

Jeffery A. Brier

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 26-81 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 26-81 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Detailed Action

Response to Amendment

1. The amendment filed on 5/27/2005 has been entered.

The amendment to pages 23 and 24 of the specification is approved.

The amendment made in the replacement sheet for figure 10 is approved and the replacement sheet is accepted.

The amendment filed 5/27/2005 is objected to under 35 U.S.C. 132(a) because it introduces new matter into the disclosure. 35 U.S.C. 132(a) states that no amendment shall introduce new matter into the disclosure of the invention. The added material which is not supported by the original disclosure is as follows: The amendment to page 22 enters new matter into the specification because of the "incorporation by reference" clause. This application did not incorporate by reference the parent applications and it is improper to now incorporate by reference the parent applications. This application was filed prior to September 21, 2004 thus incorporation by reference rules previous to new 37 CFR §§ 1.57(a)(1) & (a)(2) apply to this application.

Applicant is required to cancel the new matter in the reply to this Office Action.

Response to Arguments

2. Applicants arguments filed on 5/27/2005 have been fully considered, but, they are deemed not to be persuasive.

Response to Double Patenting

The remarks made on page 27 concerning the double patenting rejection is noted, however, the claims of the copending application have not been amended, therefore the rejection is maintained.

The remarks made on page 28 concerning the obvious type double patenting rejection is not persuasive because the rejection gave reasons why obvious double patenting is present. The rejection stated:

Comparing claim 43 of this application to claim 41 of copending application 10/428,059 and then claims 41 and 42 of this application to claim 41 of copending application 10/428,059 one sees that the claims of this application differ in scope from those of the copending application from broader to the same to more narrower.

Response to 112 arguments

The arguments on pages 21-24 have been fully considered, however, pending claims 26, 31, 36, 64, 70, and 76 are not definite. The argument on page 23 first paragraph makes reference to figure 5 and the discussion given by applicant does not correlate to the method claimed in claims 26, 31, and 36. These claims do not correlate to the specification because as stated in the rejection regarding page 13 lines 1-11 the cursor will be in the first region because "By depressing the mouse button while the cursor is positioned over certain interface elements, the mouse is disengaged from the cursor. Instead, vertical movement of the mouse adjusts the time scale and horizontal

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mouse movement adjusts the selected value at that time scale.”. The argument on page 24 first full paragraph concerning claims 64, 70, and 76 is not persuasive because the cursor needs to be in the same “region ” that both first and second components are located in in order for the first and second parameter to be controlled by the first input because as stated in the rejection regarding page 13 lines 1-11 the cursor will be in the first region to control the time scale and the value at that time scale.

The arguments on pages 24-25 have been fully considered, however, pending claims 41, 48, 52, 56, 59, 60, 63, 64, 70, and 76 are not definite. The arguments presented on pages 24-25 have been considered. Applicant on page 25 fourth paragraph asserts “that it is not necessary to literally limit the terms in the claims to what is in the original specification”. The claim scope must not go beyond that which the original specification conveys to one of ordinary skill in the art. In these claims the term depict is used and the original specification described visualizing on a display. Thus, it is not clear if applicant is intending to claim more than that which the original specification conveys to one of ordinary skill in the art.

Response to 101 arguments

The arguments on pages 25-27 have been fully considered, however, pending claims 26-81 are not statutory. On page 27 third full paragraph applicant argues “Meaning of words used in a claim is not construed in a “lexicographic vacuum, but in the context of the specification and drawing.”” Proper claim construction would look to the specification to understand the meaning of words in the claim, however, when there

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is not clear correlation between the words in the claim and the words in the specification then the claims are not in the context of the specification and drawing. Since these claims use terms not found in the specification or drawings then it would be inappropriate to read limitations into the claims.

Double Patenting

3. A rejection based on double patenting of the "same invention" type finds its support in the language of 35 U.S.C. 101 which states that "whoever invents or discovers any new and useful process ... may obtain a patent therefor ..." (Emphasis added). Thus, the term "same invention," in this context, means an invention drawn to identical subject matter. See *Miller v. Eagle Mfg. Co.*, 151 U.S. 186 (1894); *In re Ockert*, 245 F.2d 467, 114 USPQ 330 (CCPA 1957); and *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970).

A statutory type (35 U.S.C. 101) double patenting rejection can be overcome by canceling or amending the conflicting claims so they are no longer coextensive in scope. The filing of a terminal disclaimer cannot overcome a double patenting rejection based upon 35 U.S.C. 101.

4. Claims 26-40 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 26-40 of copending Application No. 10/428,059.

Claims 26-40 of this application are identical to claims 26-40 of copending application 10/428,059. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

5. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA

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1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and, *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

6. Claims 41-81 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 41-144 of copending Application No. 10/428,059. Although the conflicting claims are not identical, they are not patentably distinct from each other because the claims of this application differ in scope from those of the copending application from broader to the same to more narrower. Comparing claim 43 of this application to claim 41 of copending application 10/428,059 and then claims 41 and 42 of this application to claim 41 of copending application 10/428,059 one sees that the claims of this application differ in scope from those of the copending application from broader to the same to more narrower. Thus, these claims are obvious an obvious variation of the same thing being patented in the copending application.

Broader versions of patented claims are an obvious way for applicant to claim the same thing patented. *In re Vogel*, 422 F.2d 438, 164 USPQ 619, 623 (CCPA 1970). Vogel stated on page 623 "*The answer to the second analysis question, therefore, is yes, and the claim is not allowable in the absence of a terminal disclaimer. The correctness of this conclusion is demonstrated by observing that claim 10, by reciting "meat," includes pork. It is further noted that viewing the inventions in reverse order, i.e.*

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as though the broader claims issued first, does not reveal that the narrower (pork) process is in any way unobvious over the broader (meat) invention disclosed and claimed in the instant application.” Thus, this application’s broader claims are not unobvious over the above identified patented claims.

Thus, the minor variations between the pending claims and the patented claims is obvious type double patenting. *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970). On page 623 of *Vogel* the CCPA wrote:

[4] If it is determined that the same invention is being claimed twice, 35 U.S.C. 101 forbids the grant of the second patent, regardless of the presence or absence of a terminal disclaimer. If the same invention is not being claimed twice, a second question must be asked.

The second analysis question is: Does any claim in the application define merely an obvious variation of an invention disclosed and claimed in the patent? In considering the question, the patent disclosure may not be used as prior art. *In re Boylan*, supra; *In re Aldrich*, 55 CCPA 1431, 398 F.2d 855, 158 USPQ 311 (1968). This does not mean that the disclosure may not be used at all. As pointed out above, in certain instances it may be used as a dictionary to learn the meaning of terms in a claim. It may also be used as required to answer the second analysis question above. We recognize that it is most difficult, if not meaningless, to try to say what is or is not an obvious variation of a claim. A

[5] claim is a group of words defining only the boundary of the patent monopoly. It may not describe any physical thing and indeed may encompass physical things not yet dreamed of. How can it be obvious or not obvious to modify a legal boundary? The disclosure, however, sets forth at least one tangible embodiment within the claim, and it is less difficult and more meaningful to judge whether that thing has been modified in an obvious manner. It must be noted that this use of the disclosure is not in contravention of the cases forbidding its use as prior art, nor is it applying the patent as

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a reference under 35 U.S.C. 103, since only the disclosure of the invention claimed in the patent may be examined.

If the answer to the second question is no, there is no double patenting involved and no terminal disclaimer need be filed. If the answer is yes, a terminal disclaimer is required to prevent undue timewise extension of monopoly.

On page 623 last line to page 624 of Vogel the CCPA wrote:

Appealed claim 10, supra, will now be considered. It recites a process to be performed with "meat." "Meat" reads literally on pork. The only limitation appearing in claim 10 which is not disclosed in the available portion of the patent disclosure is the permeability range of the packaging material; but this is merely an obvious variation as shown by Ellies. The answer to the second analysis question, therefore, is yes, and the claim is not allowable in the absence of a terminal disclaimer. The correctness of this conclusion is demonstrated by observing that claim 10, by reciting "meat," includes pork. Its allowance for a full term would therefore extend the time of monopoly as to the pork process. It is further noted that viewing the inventions in reverse order, i.e. as though the broader claims issued first, does not reveal that the narrower (pork) process is in any way unobvious over the broader (meat) invention disclosed and claimed in the instant application. Emphasis added.

Thus, the slightly more narrower claims of this application are obvious over the slightly
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broader claims in copending application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

4. Claims 26-81 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 26, 31, 64, and 70:

These claims were amended to claim in the preamble "method in a graphical user interface" however a graphical user interface as described in applicants specification does not have a method. The graphical user interface is an interface a user interacts with and the interface does not have a method per se, thus, these claims do not clearly claim the invention.

Claims 26-40 and 64-81:

Claims 26 and 31 claim in the preamble "a method in a graphical user interface" and claim 36 claims in the preamble "system to implement a graphical user interface" and in the body of these claims do not set forth a method in a graphical user interface or system to implement a graphical user interface but instead sets forth "adjusting a first parameter under control of a first user interface element". From the specification the parameter under control is various values. See applicants specification at page 12 line 23 to page 13 line 11. Therefore this claim does not clearly claim the intended control.

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Is the method in a graphical user interface the issue or the control of parameters the issue? When claims 26, 31, and 36 claim "adjusting a first parameter under control of a first user interface element" it is not clear what part of the graphical user interface is controlling the parameter. The only part of applicant's specification that discusses interface elements is located on page 13 line 8. Page 13 lines 1-11 states:

In the preferred embodiment of the present invention, one parameter corresponds to a scale and the other parameter corresponds to an increment within the scale's range. The mouse is used to allow a user to simultaneously adjust both the control of the time scale and the control for scanning at the selected time scale. This is accomplished by reassigning the axes of the mouse from moving the cursor to controlling the time scale and the selected value at that time scale. By depressing the mouse button while the cursor is positioned over certain interface elements, the mouse is disengaged from the cursor. Instead, vertical movement of the mouse adjusts the time scale and horizontal mouse movement adjusts the selected value at that time scale.

Thus, it is clear the originally filed specification discussed using the interface elements to disengage the mouse from the cursor, therefore, the claims do not clearly claim what part of the graphical user interface is controlling the parameter. Similarly when claims 64, 70, and 76 claim "adjusting a first parameter depicted by a first user interface element" and "adjusting a second parameter depicted by a second user interface element" the claims do not clearly claim what part of the graphical user interface is controlling the parameter.

Claims 41-81:

Claims 41, 48, 52, 56, 59, 60, 63, 64, 70, and 76 use various forms of the word depict.

The specification describes displaying to the user via displayed control elements of the graphical user interface a visualization of the control of the scale and range. Claims 41,

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52, 56, and 60 use the phrase "being depicted by" and claims 48, 59, 64, 70, 76 use the phrase "depicted by". It is not clear from these terms the scope of the claims since the specification teaches displaying the scale or range to the user via a control element of a graphical user interface. The term depicted is abstract in that it covers more than that which is displayed to the user on display 121. The remaining dependent claims do not limit the depiction to display of the control elements on display 121. Claims 41, 52, 56, 60, and 63 use the phrase "first control element of a graphical user interface" and "second control element of a graphical user interface". The original specification did not use the term "control element". Therefore, it is not clear what part of the graphical user interface is the "control element".

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 26-81 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. This application is directed to a useful, concrete, and tangible result, however, these claims are not. These claims are directed to manipulating abstract ideas. *State Street Bank & Trust Co. v. Signature Financial Group Inc.* (CA FC) 47 USPQ2d 1596, 1603 (7/23/1998). *AT&T Corp. v. Excel*

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Communications Inc. (CA FC) 50 USPQ2d 1447. On page 1603 first paragraph the CAFC wrote in State Street:

Under *Benson*, this may have been a sufficient indicium of nonstatutory subject matter. However, after *Diehr* and *Alappat*, the mere fact that a claimed invention involves inputting numbers, calculating numbers, outputting numbers, and storing numbers, in and of itself, would not render it nonstatutory subject matter, unless, of course, its operation does not produce a "useful, concrete and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557. 7

On page 1603 paragraph labeled [4] the CAFC wrote:

[4] The question of whether a claim encompasses statutory subject matter should not focus on which of the four categories of subject matter a claim is directed to -- process, machine, manufacture, or composition of matter--but rather on the essential characteristics of the subject matter, in particular, its practical utility. Section 101 specifies that statutory subject matter must also satisfy the other "conditions and requirements" of Title 35, including novelty, nonobviousness, and adequacy of disclosure and notice. See *In re Warmerdam*, 33 F.3d 1354, 1359, 31 USPQ2d 1754, 1757-58 (Fed. Cir. 1994).

7. Claim 26-40 and 64-81 claim adjusting a parameter. This is an abstract non-tangible process. The specification does not limit the claimed term "parameter" to a tangible entity. A method in a graphical user interface is also an abstract process (claims 26, 31, 64, and 70). The claimed input device does not give the claim a practical utility. The claimed cursor is an abstract computer entity. The claims do not clearly claim what part of the graphical user interface is controlling the parameter

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making this part of the claim abstract. These claims as a whole do not produce a "useful, concrete and tangible result." *Alappat*, 33 F.3d at 1544, 31 USPQ2d at 1557.

Claims 41-48, 52, 53, 55, 56, 60, 61, 63, 64, 68-70, 74-76, 80, and 81 claim an abstract non-tangible method without a claimed practical utility. As stated above the term depicted is an abstract term that means more than displaying the control element of the graphical user interface element on display 121. Therefore the claimed functions are to an abstract non-tangible method.

Claims 49-51 and 54 claim a "position of a cursor of the graphical user interface on a display screen". This does not claim the cursor is displayed to the user, thus, the claimed cursor is an abstract computer entity.

Claims 57-59 claim switching a mouse between controlling a cursor's position on a display screen and controlling the scale and the position of the range. This does not claim the cursor is displayed to the user, thus, the claimed cursor is an abstract computer entity.

Claim 62 claims remapping the first and second axes of the input device such that the input device controls positioning a cursor of the graphical user interface. This does not claim the cursor is displayed to the user, thus, the claimed cursor is an abstract computer entity.

Claims 65-67, 71-73, and 77-79 claim "when a cursor of the graphical user interface is in the first region" and also claims "when the cursor of the graphical user interface is in the second region". This does

not claim the cursor is displayed to the user, thus, the claimed cursor is an abstract computer entity.

Objection to the Claims

8. Claims 31-35 and 70-75 are objected to because of the following informalities:

Claims 31-35 and 70-75 claim a machine readable medium containing executable computer program instructions which when executed by a data processing system cause said system to... . The "which when" clause renders these claims to claim a program per se because this clause is an intended use clause rather than an actual use clause. Thus, these claims cover a computer book or a stack of computer cards or a program per se with programs that are intended to perform the claimed functions. This is copyrightable intellectual property. The claimed machine readable medium is not claimed to be an integral part of a computer performing the claimed functions. These claims need to manifest in alignment with the specification a machine readable medium embodying machine readable instructions, said machine readable instructions causing a machine to perform a method comprising:.... .

Appropriate correction is required.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

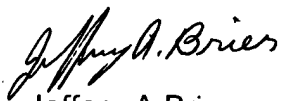
A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffery A Brier whose telephone number is (571) 272-7656. The examiner can normally be reached on M-F from 7:00 to 3:30. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael Razavi, can be reached at (571) 272-7664. The fax phone Number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Jeffery A Brier
Primary Examiner
Art Unit 2672

